

REMARKS

Claims 1, 4-10, 24-26 and 33-35 are pending. Of those, claims 1 and 10 are independent.

By this reply, claims 2-3, 11-23 and 27-32 have been canceled without prejudice to, or disclaimer of, the subject matter contained therein. Also, claims 32-35 have been added.

DRAWINGS

Beginning on page 2 of the Office Action, the Examiner objects to Figs. 5 and 3.

As to Fig. 5, the Examiner objects to item 516 therein because the Examiner believes that item 516 is not mentioned in the accompanying written description. Applicants traverse. The Examiner is requested to revisit paragraph [0007] of the present application as originally-filed, in which item 516 is affirmatively mentioned.

As to Fig. 3, the Examiner objects to items 302, 306, 312 and 320 as not illustrated. More particularly, the Examiner acknowledges that Applicants have drawn items 302, 306, 312 and 320 using “phantom lines” and seemingly infers that Applicants equate phantom lines to no lines at all. Applicants traverse.

Phantom lines typically take the form of dashed and/or dotted lines. It may be that the copy of Fig. 3 reviewed by the Examiner has phantom lines that are so faint as to have been interpreted by the Examiner as not being present at all. Accordingly, Applicants have attached another print-out of Fig. 3 for the Examiner’s convenience, one in which the weight of the phantom lines has been increased. To the extent that the Examiner can perceive the dotted phantom lines in presently submitted Fig. 3 (but could not in the originally-filed Fig. 3), Applicants submit that the enclosed drawing is not an amended drawing because the phantom lines are visible in Applicants copy of originally-filed Fig. 3. Rather, this is merely the submission of another copy of non-amended Fig. 3.

In view of the foregoing, withdrawal of the drawing objections is requested.

SPECIFICATION OBJECTION

Beginning on page 3 of the Office Action, specification is objected to as including embedded hyperlinks. By this reply, Applicants have deleted the embedded hyperlinks from paragraph [0042] and listed the same on a Form PTO-1449 enclosed with this

communication, for the Examiner's convenience in making his consideration of the hyperlinks of record. Withdrawal of this objection is requested.

§112, FIRST PARAPRAPH, REJECTION

Beginning on page 3 of the Office Action, claims 24, 27 and 30 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Applicants traverse.

More particularly, the Examiner has rejected claims 24, 27 and 30 as not being enabled because the Examiner is "unsure what hardware -- if any-- constitutes the necessary apparatus to perform the method of claim 1." The Examiner's rejection is unreasonable.

Applicants have referred to the machines in Figs. 1-2 as servers running software; see, e.g., paragraphs [0021] and [0027]. At the time the application was originally filed, servers were well known and would have been understood readily by one of ordinary skill in the art. And what one of ordinary skill in the art would have understood answers the issue raised by the Examiner, where that answer is: the present claims are enabled.

In view of the foregoing discussion, withdrawal of the rejection is requested.

§112, SECOND PARAPRAPH, REJECTION

Beginning on page 4 of the Office Action, claims 1, 2, 8, 10-24 and 30 are rejected under 35 U.S.C. §112, second paragraph, as failing to particularly point out and distinctly claim the subject matter Applicants regard as the invention. Applicants traverse.

On issue raised by the Examiner is that the present claims are indefinite because they purportedly recite plural statutory classes of invention. Again, Applicants traverse.

The Examiner draws support for the rejection from *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Int. 1990). The claim held indefinite in the Lyell case is reprinted as follows (underlined emphasis added):

2. An automatic transmission tool in the form of a workstand and method for using same comprising:
 - a support means,
 - and [sic] internally splined sleeve affixed upright to said support means,
 - a threaded adjustment bolt threadably engaged through a hole in the bottom of said support means and projecting upward through said support frame into said sleeve,
 - and further comprising the steps of

1. positioning the output end of an automatic transmission onto said upright sleeve,
2. removing the internal components of said automatic transmission from the casing of said transmission,
3. repairing and replacing said internal components back into said casing, and
4. adjusting said internal components for fit and interference by means of adjusting said upwardly projecting adjustment bolt.

In the *Lyell* case, the claim recited both a tool and a method, i.e., two classes of statutory subject matter. That is not the circumstance with the present claims. Rather, the present claims only recite one class of statutory subject matter, respectively.

As an expedient for reciting features, however, the rejected present claims refer to a claim of another statutory classification, respectively. But this claim drafting technique is not indefinite. For example, the Examiner is invited to consider claim 5 in the case of *In re Warmerdam*, 31USPQ2d 1754, 1757 (Fed. Cir. 1994). There, the Board of Appeals & Interferences (hereafter, “the Board”) at the USPTO had sustained the Examiner’s rejection of claim 5 as indefinite. The Federal Circuit, however, reversed the Board. *Warmerdam* at 1760. Claim 5 of the *Warmerdam* case is reprinted as follows.

5. A machine having a memory which contains data representing a bubble hierarchy generated by the method of any of Claims 1 through 4.

Applicants submit that the style of the rejected present claims is similar to, and thus as definitely worded as, claim 5 of the *Warmerdam* case. Moreover, the style of the rejected present claims are very different from the style held indefinite in the *Lyell* case. Accordingly, withdrawal of the rejection is requested.

Another issue raised by the Examiner is that the recitation of relative terminology (specifically, “local,” “remote” and versions thereof, respectively) renders the claims indefinite. Again, Applicants traverse.

Relative terminology is indefinite where the relation is not positively recited. Such would be the case if the present any of the rejected claims recited “local” without also citing “remote,” and vice-versa. But that is not true of each rejected claim. Rather, each rejected claim positively recites a relation by reciting both of the terms “local” and “remote.”

It is submitted that one of ordinary skill in the art would have understood the pending claims. Furthermore, Applicants submit that the Examiner has underestimated what the

routinely skilled artisan would have understood, resulting in the presentation of an unreasonable rejection.

In view of the foregoing discussion, withdrawal of the rejection is requested.

§101 REJECTION

Beginning on page 5 of the Office Action, claims 1-7, 9-15, 18-20, 22-24, 27 and 30 are rejected under 35 U.S.C. §101 because the claimed invention is direct to non-statutory subject matter. Applicants traverse.

Applicants' understanding is that the Examiner interprets that claims as representing an abstract idea that has not been reduced to some type of practical application, such as a machine-implementation of such an idea. To expedite prosecution, Applicants have amended each independent method claim as follows, taking claim 1 as an example:

1. A machine-implemented method of logging information, machine-implemented steps of the method comprising:

Accordingly, withdrawal of the rejection under §101 is requested.

§102 REJECTION

Beginning on page 5 of the Office Action, claims 1-5, 8-10, 19-25, 27-28 and 30-31 are rejected under 35 U.S.C. §102(b) as being anticipated over U.S. Patent 5,857,190 to Brown ("the '190 patent"). Claims 2-3, 19-23, 27-28 and 30-31 have been canceled, making their rejection moot. As to the other rejected claims, Applicants traverse.

The '190 patent is directed toward a system for logging events in a cable-television distribution network. In Fig. 1 of the '190 patent, a set-top box or user interface unit 26 (locally connected to a user's television) is connected via a distribution network 28 to a centralized computer or headend 22. In Fig. 1, headend 22 is remote relative to user interface unit 26.

An event evaluator 52 within user interface unit 26 evaluates events occurring at the user interface unit 26 and determines whether each such event is loggable; see col. 6, lines 65 to col. 7, line 1. If so, then event evaluator 52 reports the events to event log manager 56 located within headend 22; see col. 7, lines 15-20. No logging of events occurs at user interface unit 26. Making entries in a local log regarding such events, however, does not occur at user interface unit 26, i.e., no logging takes place that is local to user interface unit

26. Rather, logging takes place only remotely (relative to user interface unit 26) via event log manager 56 at log database 62 in headend 22.

Events can be reported to event log manager 56 as they are evaluated. Or, multiple events can be temporarily stored (buffered) in event buffer 34 (located within user interface unit 26) and then reported in a batch; see col. 7, lines 55-67. But it should be understood that buffering an event is not the same as logging the event.

A potentially misleading statement in col. 7, lines 6-7 is reprinted as follows: “The event evaluator 52 records the loggable event, but will not record the non-loggable event.” Taken out of context, it might seem as if the phrase “records the loggable event” describes local actual logging of the event. It does not. Taken within the context of the surrounding passage (and the ‘190 patent as a whole), the potentially misleading statement should be understood to mean that the event evaluator 52 causes a loggable event to be logged remotely by event log manager 56. Thus, while it might cause remote logging to occur, event evaluator 52 does not engage in local logging, i.e., logging that occurs at the user interface unit 26.

Assuming for the sake of argument that both local logging and remote logging are taught, the ‘190 patent further teaches that the decision to remotely log is made according to the same criterion as the decision to locally log. Hence, a distinction over the ‘190 patent of independent claim 1 is selectively making an entry in a remote log according to a second criterion different than the first criterion. Independent claim 10 recites a distinction similar to that of claim 1.

Claims 4-7, 8-9 and 24-25 depend at least indirectly from claim 1 and thus exhibit at least the same distinction as claim 1 over the ‘190 patent, respectively.

In view of the foregoing discussion, the §102(b) rejection is improper and its withdrawal is requested.

§103 REJECTION

Beginning on page 7 of the Office Action, claims 26, 29 and 32 are rejected under 35 U.S.C. §103(a) as being unpatentable over the ‘190 patent and to U.S patent No. 6,381,712 to Nemitz (the ‘712 patent). On page 8 of the Office Action, claims 6-7 are rejected under §103(a) as being unpatentable over the ‘190 patent taken alone. Beginning on page 8 of the Office Action, claims 11-18 are rejected under §103(a) as being unpatentable over the ‘190 patent as modified according to the reference by Chappel et al., “NetWare LAN Analysis.”

Claims 11-18, 29 and 32 have been canceled, making their rejection moot. As to the other rejected claims, Applicants traverse.

Claims 6-7 (that are rejected over the '190 patent taken alone) depend indirectly from claim 1. Thus, claim 6-7 distinguish over the '190 patent at least for the same reason as given above regarding claim 1.

Claim 26 depends indirectly from claim 1. Thus, claim 26 distinguishes over the '190 patent at least for the same reason as given above regarding claim 1. The '712 patent fails to make up for the shortcomings of the '190 patent. Thus, claim 26 distinguishes over the combination of the '190 patent and the '712 patent.

In view of the foregoing discussion, all §103 rejections based upon the '190 patent are improper and withdrawal of those rejections is requested.

NEW CLAIMS 33-35

Newly added claims 33-35 depend from claim 1, respectively. As such, each of claims 33-35 distinguish over the art at least for the same reasoning as does claim 1, respectively.

CONCLUSION

The issues in the case are considered to be resolved. Accordingly, Applicants again request a Notice of Allowability.

In the event that there are any outstanding matters remaining in the present application, the Examiner is invited to contact the undersigned to discuss the present application.

< remainder of page intentionally left blank >

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-2025 for any additional fees under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

Daniel E. Ford, et al.

By:



Thomas S. Auchterlonie
Reg. No. 37,275

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. Box 8910
Reston, VA 20195
(703) 668-8000

TSA/krf:tsa

enclosure: Courtesy Copy, Fig. 3
 Form PTO-1449